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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,398	12/06/2001	Yasuhisa Fujii	15162/04090	3035
24367	7590	12/16/2004		
SIDLEY AUSTIN BROWN & WOOD LLP 717 NORTH HARWOOD SUITE 3400 DALLAS, TX 75201			EXAMINER SINES, BRIAN J	
			ART UNIT 1743	PAPER NUMBER

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/008,398

Applicant(s)

FUJII ET AL.

Examiner

Brian J. Sines

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/23/2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

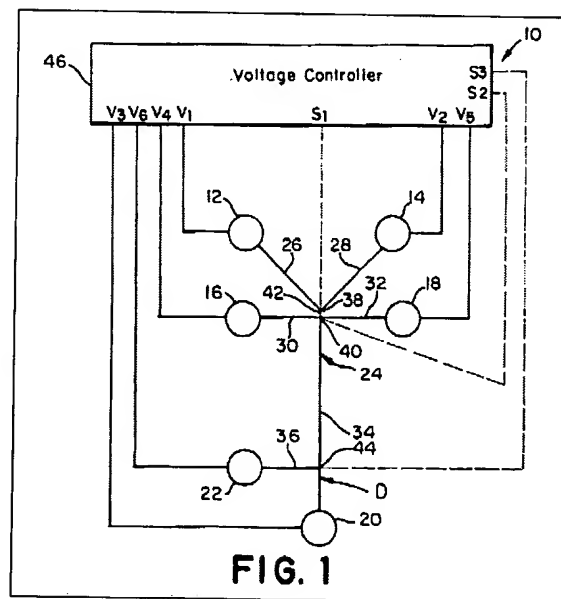
Claims 1 – 3, 7, 8, 13, 17, 22 – 24, 28 – 30, 34 – 36, 42 and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by Ramsey (U.S. Pat. No. 5,858,195 A). Regarding claims 1, 2, 7, 8, 13, 22 – 24, 28 – 30 and 34 – 36, Ramsey teaches an apparatus comprising: a plurality of supply units (e.g., 12 & 14) capable of supplying a plurality of fluids; a reaction chamber or channel (42) for receiving the plurality of fluids; and a flow pass or channel branches (e.g., 26 & 28) connected between the plurality of supply units and the reaction chamber. Regarding claim 3, Ramsey teaches the incorporation of an additional reservoir or port (20) for receiving discharged fluids (see col. 6, lines 15 – 67; col. 7, lines 1 – 12; figures 1 & 6). The Courts have held that apparatus claims must be structurally distinguishable from the prior art in terms of structure, not function. See *In re Danley*, 120 USPQ 528, 531 (CCPA 1959); and *Hewlett-Packard Co. V. Bausch and Lomb, Inc.*, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). The Courts have held that the manner of operating an apparatus does not differentiate an apparatus claim from the prior art, if the prior art apparatus teaches all of the structural limitations of the claim. See *Ex Parte Masham*, 2 USPQ2d 1647 (BPAI 1987) (see MPEP § 2114).

Regarding the methodology of using the apparatus as recited in claims 34 – 36 and 42 and 43, as discussed above, Ramsey teaches all of the structure of the apparatus

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provided in the claimed method, which merely recites the conventional operation of that apparatus. Ramsey teaches that the apparatus is operated to transport and mix sample and reagent fluids in accordance to a timed sequence (see col. 9, lines 25 – 63).

Regarding process or method claims, a prior art device anticipates a claimed process, if the device carries out the process during normal operation (see MPEP § 2112.02). The Courts have held that when a prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed that the device will inherently perform the claimed process. See *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986). In addition, regarding product and apparatus claims, when the structure recited in the reference is substantially identical to that of the claims, claimed properties or functions are presumed to be inherent (see MPEP § 2112.01).



Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 4 – 6, 9 – 12, 14 – 16, 18 – 21, 25, 31 – 33 and 37 – 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramsey in view of Anderson et al. (U.S. Pat. No. 5,922,591 A). Regarding claims 4, 5, 14, 18, 21, 25, 37, 40 and 41, Ramsey does not specifically teach the incorporation of a vacuum or suction means with an associated controller means for facilitating fluid transport within the apparatus. Ramsey do teach the use of controlled electrokinetic fluid transport within the apparatus (see col. 9, lines 7 – 24). Anderson et al. do teach the incorporation of a pressure manifold, which provides a suction or vacuum effect, for facilitating fluid transport within a microfluidic apparatus (see col. 26, lines 8 – 67). Hence, as evidenced by Ramsey and Anderson et al., both of these fluid transport mechanisms for facilitating fluid transfer within microfluidic devices are considered functional equivalents recognized in the prior art (see MPEP § 2144.06).

The Courts have held that an express suggestion to substitute one known equivalent

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component or process for another is not necessary to render such a substitution obvious. See *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982). Therefore, it would have been obvious to a person of ordinary skill in the art to incorporate a suction means, as taught by Anderson et al., with the microfluidic apparatus of Ramsey in order to provide for effective fluid transport within the apparatus. Regarding claims 6, 9, 10, 14, 16, 18, 20, 25, 27, 31, 33, 37 and 39, Ramsey further teaches the incorporation of micropumps (see col. 35, lines 4 – 65). Regarding claims 11, 12, 14, 15, 18, 19, 25, 26, 31, 32, 37 and 38, Ramsey teaches the incorporation of valves within the system (see col. 35, lines 3 – 11).

Response to Arguments

1. Regarding the rejection claims 19 – 21 under 35 U.S.C. 112, second paragraph, applicant's arguments and amendments have been fully considered and are persuasive. This rejection has been withdrawn.
2. Regarding claim rejection of claims 1 – 3, 7, 8, 13, 17, 22 – 24, 28 – 30 and 34 – 36 under 35 U.S.C. 102(b) as being anticipated by Ramsey (U.S. Pat. No. 5,858,195 A), applicant's arguments filed 9/23/2004 have been fully considered, but they are not persuasive. The applicant contends that the Ramsey apparatus does not teach or suggest essentially the flow pass or channel feature of the claimed invention. As shown in figures 31A, 31B and 31C, for example, Ramsey does indicate that the relative arrangement of the wells and channels can affect the rate of flow of the reagents utilized within the apparatus during operation (see col. 33, line 13 – col. 34, line 27). The applicant is advised that although, the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181,

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26 USPQ2d 1057 (Fed. Cir. 1993); *In re Barr*, 170 USPQ 330 (CCPA 1971). “The PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art.” See *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). “During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.” See *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). “The PTO broadly interprets claims during examination of a patent application since the applicant may ‘amend his claim to obtain protection commensurate with his actual contribution to the art.’” (quoting *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550 (CCPA 1969)). See *In re Yamamoto*, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984). The applicant cannot read limitations set forth in the description into the claims for the purpose of avoiding the art. See *In re Sporck*, 155 USPQ 687 (CCPA 1967). Although the apparatus as taught by the prior art may not be what the applicant intends as their claimed invention, the claims still encompass the teachings of the prior art. Therefore, the claims still do not *exclude* the teachings of the prior art.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the


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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Sines, Ph.D. whose telephone number is (571) 272-1263. The examiner can normally be reached on Monday - Friday (11:30 AM - 8 PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jill Warden
Supervisory Patent Examiner
Technology Center 1700